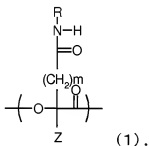


D. Remarks

The claims are 1-10, with claims 1, 3, and 5-8 being independent. Claims 3, 5-8, and 10 have been withdrawn from consideration as being directed to non-elected subject matter. The specification has been amended to correct typographical errors. No new matter has been added. Reconsideration of the present claims is respectfully requested.

Claims 1, 2, 4, and 9 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious from WO 2004/061530 (Mihara) in view of the Moore et al. article (Moore). The grounds of rejection are respectfully traversed.

The presently claimed invention, in pertinent part, is related to a polyhydroxyalkanoate (PHA), which includes the unit of formula (1):



The Examiner stated that this formula (1) is a homologue of formula (1) in Mihara, with the sole difference residing in the extra CH<sub>2</sub> group between the oxygen and the side chain in Mihara. The Examiner alleged that the presently claimed invention is *prima facie* obvious from Mihara since, as homologues, the PHA in the present claims and

the PHA in Mihara would have been expected to have similar properties. Applicants respectfully disagree.

Applicants respectfully submit that a modification of the backbone of the PHA changes the physical properties of the PHA. Applicants respectfully submit that the poly-2-hydroxyalkanoate of the present invention is believed to have better thermal properties, solubility, and hardness than a poly-3-hydroxyalkanoate of Mihara. Also, in accordance with the present invention, it is possible to provide the polymer via organic reactions (see examples in the present specification) at a low cost. Mihara discloses a synthesis method in which a biochemical reaction using a microorganism, enzyme etc., is used (see examples in Mihara).

Regardless, Applicants respectfully submit that Mihara is not prior art under 35 U.S.C. § 103. Specifically, the present application is a U.S. national stage of International Application No. PCT/JP2005/011000, which was filed on June 9, 2005 and claims priority from Japanese Application No. 2004-174788, filed on June 11, 2004.<sup>1</sup> Mihara was filed on December 23, 2003 and published on July 22, 2004. Thus, Mihara was published after the filing date of priority Japanese Application No. 2004-174784. While Mihara was filed before the priority Japanese application, it can only qualify as prior art under 35 U.S.C. § 102(e) based on its filing date. However, since Mihara and the claimed invention were, at the time the invention was made, owned by, or subject to an

---

<sup>1</sup> To perfect the foreign priority claim in accordance with 37 C.F.R. § 1.55, Applicants are preparing and will shortly submit a sworn translation of JP 2004-174788. Should the Examiner review this case before the translation is submitted, the Examiner is requested to contact the undersigned before issuing

obligation of assignment to, Canon Kabushiki Kaisha,<sup>2</sup> Mihara cannot be used as prior art in an obviousness rejection in view of 35 U.S.C. § 103(c).

Moore does not affect the patentability of the presently claimed invention. Moore was cited for the disclosure related to the use of hydrocarbon chains to affect the overall hydrophobic properties of molecules. However, this reference does not disclose or suggest the PHA structure as claimed.

Claims 1, 2, 4 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-4 and 6 of co-pending Application Nos. 11/165,356 and 11/165,357.

Under M.P.E.P. § 804(I)(B), if the provisional double patenting rejection is the only rejection remaining in the application, this rejection should be withdrawn, so that the case can proceed to issue as a patent. Furthermore, Applicants believe that the filing of terminal disclaimers at this juncture is premature. The above rejections are merely provisional and none of the claims has been indicated as allowable. Applicants, for example, would need to pay a fee for the recordation of each terminal disclaimer, which is non-refundable, should the withdrawal of the disclaimer need to be requested due to additional future amendments or should this application be abandoned in favor of a continuation. In that regard, Applicants will also have additional expenses associated with, for example, re-recording the terminal disclaimers in the continuation or requesting withdrawal of the terminal disclaimers.

---

another action on the merits.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

/Jason M. Okun/  
Jason M. Okun  
Attorney for Applicants  
Registration No.: 48,512

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200  
FCHS\_WS 2625505\_1.DOC